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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,504	06/07/2001	Philip H. Burrus IV	EN11309	9312

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Motorola Energy Systems Group
Intellectual Property
1700 Belle Meade Court
Lawrenceville, GA 30043

EXAMINER

LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,504

Applicant(s)

BURRUS, PHILIP H.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-4 and 6-16 have been examined. Application 09/876,504 (ELECTRONIC COUPON AND CUSTOMER DATA ACQUISITION APPARATUS AND METHOD) has a filing date 06/07/2001.

Response to Amendment

2. In response to Final Rejection 09/03/04, the Applicant filed an RCE. No claims were amended or added.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al (U.S. 6,243,447) in view of Freeman et al (U.S. 6,450,407).

As per claim 1, Swartz teaches:

An electronic savings system, the system comprising:

a portable electronic device having unique personal identification data stored therein (see Swartz column 7, lines 10-16; column 9, lines 30-37) and;

a means of transmitting the unique personal identification data to a store (see Swartz column 7, lines 10-16; column 9, lines 30-40);

Swartz does not expressly teach wherein when the store receives the unique personal identification data, a store discount is applied to a plurality of specially marked

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store discounted items. Freeman teaches that the value of the rebate may be greater for frequent, loyal shoppers than for shoppers that make one-time purchases only for a short time period. Also, Freeman teaches that Loyalty rebating causes the rebates to increase as a consumer purchases more of a particular product (see column 11, lines 9-12; column 18, lines 1-5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Swartz system would transmit to a store's central computer the customer's personal identification and purchase data which would be used by the store's central computer to adjust the discount given to particular or specially mark purchase products, as taught by Freeman. This feature would increase the customer's loyalty to particular products, as the customer's purchase profile would be used to adjust the discounts given to the customer for purchasing more of a particular or specially mark product.

As per claim 2; Swartz and Freeman teach:

The system of claim 1, but fails to teach further comprising a simulated credit card swipe coupled to the portable electronic device (see Swartz column 10, lines 49-51).

As per claim 3, Swartz and Freeman teach:

The system of claim 1, teach wherein the portable electronic device comprises a cellular telephone and the unique personal identification data comprises a user's telephone number (see Swartz column 7, lines 10-17).

As per claim 4, Swartz and Freeman teach:

The system of claim 3 wherein the universal savings system comprises a discount card associated with a particular store (see Freeman column 10, lines 50-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Swartz would use a store's loyalty card to track customers' purchase history and target promotions to the customers, as taught by Freeman. Targeting promotions based upon the customers' purchase profile would increase the probability that the promotions would reach the intended target.

As per claim 6, Swartz teaches:

A method of acquiring customer data, the method comprising the steps of:

a. providing a portable electronic device having unique personal identification data stored within, wherein the portable electronic device comprises a means of transmitting the unique personal identification data (see Swartz column 7, lines 10-16; column 9, lines 30-40);

b. providing a store register capable of receiving the unique personal identification data (see Swartz column 10, lines 40-67);

c. transmitting the unique personal identification data from the portable electronic device to the store register (see Swartz column 10, line 40 – column 11, line 27); and

d. Swartz fails to teach applying a store discount to the price of all specially marked, store discounted items upon receipt of the unique personal identification data

The same rejection applied to claim 1 is applied to claim 6.

As per claim 7, Swartz and Freeman teach:

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The method of claim 6, further comprising the steps of:

- a. providing a central computer (see Swartz figure 3, item 73);
- b. transmitting the unique personal identification data to the central computer

(see Swartz column 9, lines 30-37) and

- c. cross referencing the unique personal identification data with a stored data profile (see Swartz column 11, lines 20-29).

As per claim 8, Swartz and Freeman teach:

The method of claim 7, further comprising the steps of:

- a. transmitting product data from the store register to the central computer

(see Swartz column 10, line 40 – column 11, line 29); and

- b. storing the product data with a cross-reference to the unique personal identification data (see Swartz column 11, lines 20-29).

As per claim 9, Swartz and Freeman teach:

The method of claim 7, wherein the product data is used for inventory management (see Swartz column 4, lines 21-26).

As per claim 10, Swartz teaches:

A method of acquiring customer data, the method comprising the steps of:

- a. providing a store register capable having unique store identification data stored within, wherein the store register comprises a means of transmitting the unique store identification data (see Swartz column 7, lines 30-40);

- b. providing a personal electronic device capable of receiving the unique store identification data (see Swartz column 9, lines 30-38);

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c. transmitting the unique store identification data from the store register to the portable electronic device (see Swartz column 9, lines 30-38); and

d. Swartz fails to teach applying a store discount to the price of all specially marked, store discounted items upon successful transmission of the unique store identification data. However, the same rejection applied to claim 1 is applied to claim 10.

As per claim 11, Swartz and Freeman teach:

The method of claim 10, further comprising the steps of:

a. transmitting the unique store identification data from the personal electronic device to a remote computer (see Swartz column 9, lines 30-37);

b. transmitting customer data from the personal electronic device to a remote computer (see Swartz column 9, line 46 – column 10, line 24); and

c. transmitting product data from the personal electronic device to a remote computer (see Swartz column 9, line 46 – column 10, line 40).

As per claim 12, Swartz and Freeman teach:

The method of claim 11, further comprising the steps of:

a. processing the unique store identification data, the customer data and the product data (see Swartz column 10, line 40 – column 11, line 28); and

b. producing a report with the unique store identification data, the customer data and the product data listed in an organized format (see Swartz column 3, lines 35-38; column 11, lines 20-27).

As per claim 13, Swartz and Freeman teach:

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The method of claim 12, wherein the personal electronic device comprises a cellular telephone (see Swartz column 6, lines 20-25).

As per claim 14, Swartz and Freeman teach:

The method of claim 13, wherein the store register is linked to at least one other store register via a network (see Swartz figure 3). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a store would have a plurality of store registers linked to each other and connected to a central computer via a network (see Swartz figure 3, item 73). This feature would allow the store's central computer to keep track of all purchases done in each of the store's cash register.

As per claim 15, Swartz and Freeman teach:

The method of claim 14, further comprising the step of distributing advertising literature based upon the report (see Swartz column 4, lines 21-32). Freeman teaches targeting advertisement based upon customer's purchase history (see column 12, line 62 – column 13, line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Swartz's system would use the customers' purchase history to target promotions to customers, as taught by Freeman. Targeting promotions based upon the customers' profile would increase the probability that the promotions would reach the intended target.

As per claim 16, Swartz and Freeman teach:

The method of claim 14, further comprising the step of using the report for inventory management (see Swartz column 4, lines 20-26).

Response to Arguments

4. Applicant's arguments filed 11/09/04 have been fully considered but they are not persuasive. The Applicant argues that the Applicant's claimed invention is targeted for an in-store, store-based discount for a plurality of items, similar to the Harris-Teeter VIC card, wherein cardholders are offered store discounts on a plurality of items in exchange for submitting personal information so that the store may track buyer shopping patterns. The Applicant further argues that as such, it is store discount rather than a third-party coupon, that is provided locally and that the discount is provided to a plurality of products. The Examiner answers that any coupon or discount accepted and redeem by a store is considered a store's discount coupon. Also, the Applicant is arguing about features that are not in the claims. The Applicant's claims recite "a portable electronic device, having unique personal identification data stored therein; and a means for transmitting the unique personal identification data to a store; wherein when the store receives the unique personal identification data, a store discount is applied to a plurality of specially marked, store discounted items". For the Examiner, a customer's identification, shopping list, coupon list, and all the items stored in the customer's portable electronic device and transmitted to the store's central computer, as taught by Swartz column 3, lines 30-40; column 8, lines 15-24 would be classified as unique customer's personal identification data.

The Applicant argues that Swartz talks only of a self-checkout system. The Applicant further argues that there is no mention in Swartz of either discounting or identifying a customer and then discounting a plurality of specially marked items upon

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receiving the identification information. The Examiner answers that Swartz teaches in column 8, lines 15-22; column 11, lines 15-16 that customers can scan coupons into the portable device to later redeem them in a store cash register.

Conclusion

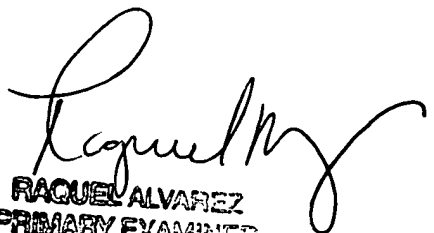
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
January 19, 2005


RAQUEL ALVAREZ
PRIMARY EXAMINER